

REMARKS

Applicants appreciate the consideration of the present application afforded by the Examiner. Claims 1, 2, 4, 5, 7, 8, 10, and 11 were pending prior to the Office Action. Claims 13 and 14 have been added through this Reply. Therefore, claims 1, 2, 4, 5, 7, 8, 10, 11, 13 and 14 are pending. Claims 1 and 7 are independent. Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks.

35 U.S.C. § 112, 1st Paragraph Rejection

Claims 1 and 7 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement, specifically regarding the claim limitation “*wherein the attributes are not user-definable.*”

Although Applicants do not necessarily agree with the Examiner's assertion that the aforementioned limitation is not described in the original specification, the present amendment removes the limitation from the claims, rendering the rejection under § 112, first paragraph moot.

Accordingly, Applicants respectfully request that the §112, first paragraph rejection of claims 1 and 7 be withdrawn.

Claim Rejections - 35 U.S.C. §102

Claims 1, 2, 4, 5, 7, 8, 10, and 11 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 6,389,435 to Golovchinsky et al. (“Golovchinsky”). Applicants submit the Examiner has failed to establish a *prima facie* case of anticipation and traverse the rejection.

In order to establish a *prima facie* case of anticipation under 35 U.S.C. §102, the cited reference must teach or suggest each and every element in the claims. *See M.P.E.P. §2131; M.P.E.P. §706.02.* Accordingly, if the cited reference fails to teach or suggest one or more claimed elements, the rejection is improper and must be withdrawn.

Golovchinsky teaches a system and method whereby digital ink marks made on a term of an index of a document (i.e., a categorical reference found at the end of a document such as a “back of the book” index; *see Fig. 2 and col. 2, lines 28-36*) are

copied throughout the document over all of the instances of the term. *See col. 1, line 66 – col. 2, line 36.* Golovchinsky further teaches that attributes of a digital ink mark can affect the manner in which the selected terms are searched in the rest of the document, for example, by assigning weight to certain terms. *See col. 4, lines 27-57.*

However, the invention described by Golovchinsky is not the same as the present invention, and Golovchinsky cannot teach or suggest at least the features of independent claims 1 and 7.

Independent claim 1 recites, *inter alia*, a method comprising the steps of:

- (a) receiving a plurality of annotated documents, each of the annotated documents including a Web-based document associated with corresponding annotation data;

- (b) including values of at least one attribute of the annotation data for each of the plurality of annotated documents in at least one searchable annotation database;

- (c) searching the values of the at least one attribute in the at least one annotation database according to search criteria;

- (d) obtaining a set of annotated documents that is a subset of the plurality of annotated documents based on a result of said searching step.

According to the features of independent claim 1, attributes of annotation data for a plurality of annotated documents are able to be searched based on search criteria. As a result, a subset of the plurality of annotated documents can be obtained, the subset corresponding to annotated documents which are somehow related to the search criteria. For example, documents annotated with annotations (e.g., digital ink marks) can be organized based on certain attributes of the annotations, such as the time/date when the annotations were made, an author of the annotations, the shape of the annotation, etc. *See, for example, paragraphs [0083] and [0084] of the Specification.*

In contrast, the system described by Golovchinsky does not search attributes of annotation data according to search criteria. The digital ink marks of Golovchinsky are placed by a user on the index of a document. *See Figure 2, elements 42 and 44.* A search of the document is then performed for like instances of the selected term and copies of the same digital ink mark are placed at those instances. *See Figures 3-5, col.*

In other words, the index described by Golovchinsky is not a searchable database of annotation attributes, but is instead a typical “back-of-the-book” index for referencing terms and/or concepts within a document. Also, the index of Golovchinsky is not searched based on attributes of annotations; rather, the document is searched to determine the locations of instances of terms or passages relevant to the term in the index selected with a digital ink mark by the user.

Furthermore, Golovchinsky does not teach or suggest receiving a plurality of annotated documents associated with annotation data. The document described by Golovchinsky is not annotated until the user places a digital ink mark upon a term in the index. Also, Golovchinsky does not teach or suggest searching multiple documents for values of attributes of the annotation data based on search criteria. Indeed, Golovchinsky only discloses searching through the content (not the annotations) of one document based on the terms in the index of that document which are selected by the user. *See col. 5, lines 35-41.*

Clearly, Golovchinsky cannot teach or suggest at least the features of independent claim 1. Therefore, at least because Golovchinsky fails to teach or suggest each and every claimed element, independent claim 1 is distinguishable from the prior art. Reasoning presented above with respect to claim 1 is also applied herein with respect to claim 7. Therefore, at least due to the reasons presented above with respect to claim 1, claim 7 is also distinguishable from Golovchinsky. Dependent claims 2, 4, 5, 8, 10, and 11 are also distinguishable from the prior art at least due to their dependence from claims 1 and 7, directly or indirectly. Accordingly, Applicant respectfully requests that the rejection of claims 1, 2, 4, 5, 7, 8, 10, and 11 under 35 U.S.C. § 102(b) be withdrawn.

New Claims

New claims 13 and 14 have been added through this Amendment, and are considered to be in condition for allowance at least due to their dependence upon in claims 1 and 7, respectively. No new matter has been entered.

CONCLUSION

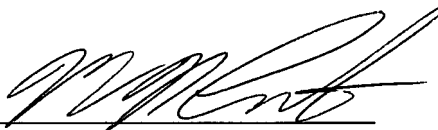
All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Notice of same is earnestly solicited.

If the Examiner has any questions concerning this application, please contact John R. Sanders (Reg. No. 60,166) at the telephone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

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Respectfully submitted,

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